

**AMENDMENTS TO THE DRAWINGS:**

The attached sheet of drawings includes changes to FIG 2, which is now labeled as FIG. 2C. The replacement sheets also include new FIGs. 2A, 2B, 6A, 6B, 6C, and 20-24. Each of these figures was filed in the provisional application that was incorporated by reference in this present application.

Attachments:        Replacement Sheets include 1 page FIG. 2C  
                         New Sheets 17 pages including FIGs. 2A-B, 6A-C, and 20-24  
                         Exhibit A (1988 materials)  
                         Exhibit B (copy of specification as amended)

**REMARKS**

Applicants, through new counsel, hereby respond to the outstanding Office Action of September 20, 2005. A Revocation of Power of Attorney and Grant of a New Power of Attorney was filed on November 21, 2005. This application was filed on November 28, 2000, and claims priority to a provisional application filed on April 27, 2000. While there have been several Office Actions and Responses filed during the prosecution of this application, circumstances have thus far led to relatively little substantive examination of the claimed inventions and a comparison of the claimed inventions with the prior art. Applicants through this amendment have carefully considered the Examiner's requests, and they investigated relevant materials and information available to Applicants. Applicants have also amended the specification, drawings, and claims, taking care that the amendments are fully supported by the originally filed provisional and formal application. Applicants in this Amendment present responses and amendments that are believed to place the case into condition for full substantive examination and allowance.

**History Leading to the Outstanding Office Action**

During the examination of this application, the Examiner has sought access to Applicants' now working and commercially applied website, and Applicants provided that access. Next, the Examiner issued a restriction requirement, and Applicants made an election.

In response to the Examiner's restriction requirement, Applicants elected then pending claims 1-22 drawn to a process of providing real estate information. Then

pending claims 23-46 were found by the Examiner to be directed to competitive marketing analysis and were not elected.

The Examiner then accurately noted that a webpage form dated January 25, 1999 indicated that beginning as of December 15, 1998, Listingbook would be unable to provide new property information and that the outage would continue indefinitely. The Examiner therefore sought information regarding whether there was any use of the website over the Internet prior to January 25, 1999. Applicants in turn provided a brief explanation and provided the Office with 7 pages of printouts that were available prior to April 27, 2000 (the date the provisional was filed). Applicants explained that these printouts were obtained from web.archive.org. Pages from that archive source indicate that on December 5, 1998 and December 11, 1998 a website was available but that later (Jan. of 1999, Feb. of 1999, Oct. of 1999, Nov. of 1999, and Mar. of 2000), the site was no longer available. This submission led to the most recent Office Action, to which Applicants are responding.

#### **The Outstanding Office Action**

Applicants appreciate the thoroughness of the Examiner's review of the application and the information of record and understand that the Examiner, as part of the examination, wants to review available information regarding Applicants' early work toward the inventions described and claimed in this application. Applicants therefore have thoroughly reviewed the relevant information they could locate, to respond to the Action.

In the outstanding Office Action, the Examiner correctly noted that Applicants on Fig. 2 identified Listingbook Services as incorporating the embodiments of the claimed

invention. That statement is accurate as of the date Applicants filed their formal applications. However, as explained below, Applicants completed their invention well after 1998, when they did some early testing. For approximately three months in 1998, Applicants did use a website and the Internet as part of their effort to make their inventions. As indicated on two of the seven copies of webpages Applicants previously provided to the Office, a person could not access their personal webpage through this Applicants' 1998 website, unless that person first entered a user code into a box on the website. The only persons that could do so were test agents and tests buyers who in 1998 were given the web address of the test system and respective access code numbers. Applicants did not charge the agents or their buyers for the use of the test system, during the 1998 testing. After this early testing, the inventors worked for over two years before the invention was completed and placed into working, commercial operation. None of this work, other than the preliminary testing in 1998, was done on the Internet or through a website available on the Internet. Applicants respectfully submit, for the reasons expressed below, that this early, preliminary testing does not constitute prior art under the patent law or the practice of this Office. See M.P.E.P § 2133.03.

As the Examiner noted, the website shown in Exhibits A and B of the 7 pages already provided by Applicants included what appeared to be links identified as "About This Site," "Listingbook Demo," "Buyer Agency," "Community Links," and "Help Desk." In view of these circumstances, the Examiner requested further information. For example, the Examiner's *Requirements for Information* requests that Applicants "please provide list of features, FAQ, help information, services provided to plurality of user

types by this websites, any known publications, papers, brochures, manual and press releases that describe providing Real Estate information using a computer network, such as the Internet.” *Requirement for Information*, page 2. Applicants were also “requested to clarify whether websites www.listingbook.com and www.listingbook.net are affiliated websites, because the Examiner apparently found that a user from www.listingbook.com is transferred to www.listingbook.net.” *Id.*

### **Response to Request For Information**

In 1998, Applicants performed some experimental testing, as part of their developmental efforts to make their invention. During that testing, Applicants developed and opened a web site and made it available to some agents, and their buyers. As part of that testing, Applicants gained access to a multiple listing service in a limited geographical area where they lived, so that the data on the multiple listing service could be available for use with their preliminary tests. During this testing, test agents and buyers within the test could access the Applicants’ then-existing preliminary system through the Internet by using accounts and passwords provided by Applicants. Neither the agents nor the buyers compensated Applicants in any manner during this testing. Nor did Applicants otherwise receive any form of compensation. After approximately three months, the testing was stopped, and the website was closed. Applicants then worked on and perfected their invention for more than a year before they constructively reduced their invention to practice by filing a provisional application and by later filing this formal patent application. Applicants did not commercialize their invention and place the invention onto a website until months after they filed the formal application on November 28, 2000.

On page 2 of the office action, the Examiner correctly noted that Exhibit A “shows plurality of links including a link for ListingBook demo.” In response to the Examiner’s requests, Applicants have attempted to reconstruct what was available in 1998 under that link and submit Exhibit A, which includes 16 pages. Applicants believe that these 16 pages were available to test participants and represent what would have been provided if a person in 1998 had found the website and then “clicked” the link “ListingBook Demo.” The computer used by Applicants in 1998 during the testing was destroyed by water damage caused by a fire. Applicants therefore have not been able to review or copy the actual digital data or materials that existed in 1998. Applicants were, however, able to reconstruct the 16 pages at Exhibit A and believe these pages accurately illustrate what was available in 1998 as a demo. Applicants have not been able to reconstruct any other materials or information that a person in theory could have obtained if the person found and gained access to the test website. Applicants can state, however, that at that time the test system they prepared did not have active links or information regarding the “About This Cite,” “Buyer Agency,” “Community Links,” and “Help Desk” features.

To the best of Applicants’ recollection, page 1 of Exhibit A is the “Welcome” or home page of the test website, a website that was available on the Internet for about 3 months, from approximately September of 1998 through mid December of 1998. During the testing, approximately 23 test agents and 73 test buyers were provided with a user code. These persons did not have access to the software of the test and were not otherwise told how the computer system was operated to provide the information available to them through the use of the test website. The test agents understood that

the system was being tested, and they did not compensate Applicants or anyone else for the right to use the test system.

Applicants used the Listingbook website for preliminary testing. Test agents and buyers logged into their Webpages by entering their test login code. Test agents were provided with a webpage with links to their test buyers' webpages. Page 2 of Exhibit A illustrates the webpage a buyer would see, after logging in. Page 3 is the webpage that would be provided, if the buyer activated the How to Use Your Listingbook link, and page 4 is the For Sale Property list that a buyer could access. Page 5 illustrates what a buyer would see, if he or she activated the price change information button. Page 6 is an illustration of a Photo Report. Page 7 again illustrates a photo report, but also indicates that a buyer, when viewing a photo report, could select a yahoo map or a loan report. Page 8 illustrates an example of a yahoo map available from the test website, and page 9 illustrates an example of a loan report available from the test website. If a buyer activated the Tab It! button, he could select or highlight a particular property as one of interest. Page 10 is a For Sale Property List page. The page indicates that the buyer could also select Area/Price Only or All Profile Items. Page 11 illustrates a For Sale Property List under Area/Price Only and also indicates that a buyer could select Order of Listings by price, sub-division, square feet, baths, levels, bedrooms, age, or days on market. Page 12 illustrates a Changed Property List, and Page 13 illustrates a Tagged Property List. Page 14 is a Your Profile property requirements page available to a buyer. Page 15 illustrates that information could be emailed to a person at Listingbook, and page 16 illustrates that information could be emailed to a person's e-mail address.

During the preliminary test, a test agent could go to listingbook.com, enter the access code, and be provided with an webpage listing the agent's buyers who had access to the website and had used the test system. The agent could activate a particular buyer and then have access to the buyer's account and see the same information that was available to the buyer. The agent thus could see the same account page that the buyer would see. During the testing, an agent could not enter buyer information into the buyer's account. Instead, any information from an agent was faxed or otherwise provided to Listingbook which could then enter the information into the buyer's account.

After the testing ended in December of 1998, Applicants worked for over a year to complete their invention and constructively reduce it to practice. They did not place the system onto the Internet and make it available to agents and their clients until approximately January of 2001, approximately two years after the 1998 test website was no longer available and well after the provisional and formal application were filed. The illustrations of webpages included in the provisional and formal application drawings were not available to anyone other than the inventors or personnel of Listingbook and were not available publicly, by the Internet or otherwise, until after the formal application was filed.

In response to the other question of the Examiner, Applicants state that www.listingbook.com and www.listingbook.net are affiliated websites as of today. However, In 1998 during the testing, only the www.listingbook.com website was available, for the short time previously discussed.



Applicants bring this information to the Examiner's attention in response to the Examiner's requests and in accordance with the duty of disclosure. Applicants recognize that their 1998 website was at least in theory available on the Internet, if a person having access to the Internet ever typed in the address of listingbook into a server. Applicants are unaware of any index or similar system that would have allowed a person, other than authorized testers, to learn about and find the website. Applicants did not advertise their test system or service in 1998 or otherwise disclose their test website or system to the general public.

With respect to the 1998 testing, Applicants respectfully submit that this testing is not prior art. Applicants direct the Examiner's attention to M.P.E.P. §2133.03 in its entirety. As exemplary only, Applicants note that their invention was not complete during the 1998 testing but instead required years of additional work, before the invention was completed and ultimately commercialized in 2001. The 1998 work was experimental and preliminary in nature. Applicants further note that inventors are permitted to perform tests needed to learn whether a potential invention is capable of performing its intended purpose in its intended environment. *Gould Inc. v. United States*, 217 Ct. Cl. 167, 579 F.2d 571, 583 (1978); *see also EZ Dock, Inc. v. Schafer Sys., Inc.*, 276 F.3d 1347, 1352 (Fed. Cir. 2002).

#### **Amendments to the Specification and Drawings**

Applicants have amended the drawings and specification to include within the formal patent application additional illustrations and information contained in the provisional, to which Applicants claim priority. Care has been taken to ensure that no new matter has been added.

To assist the Examiner in the examination of the application, Applicants are submitting as Exhibit B a copy of the Specification as amended, with additional identified by underlining and deletions in brackets. Applicants can provide the Examiner with a substitute specification, in hard or digital form, if that would assist the Examiner or the Patent Office.

### **The Amendment to the Claims**

To move the prosecution of this case forward, Applicants have cancelled original claims and added new claims 47-121. These new claims have been drafted with Applicants' prior election in mind. Applicants believe the new claims fall within the scope of the their election and note that all of the pending claims fall within the scope of the broadest independent claim. Applicants accordingly submit that the claims can and should be examined without any further restriction requirement. If the Examiner for any reason disagrees, Applicants respectfully request that the Examiner contact the undersigned by phone, so that any further election can be made promptly, thereby promoting the prompt examination of the case, which is already several years old. Applicants reserve their right to pursue the full scope of their disclosed inventions in divisional or continuation applications, as the prosecution of the case continues.

Applicants respectfully submit that these claims are patentable over the prior art and therefore seek a prompt substantive examination of the claims.

### **CONCLUSION**

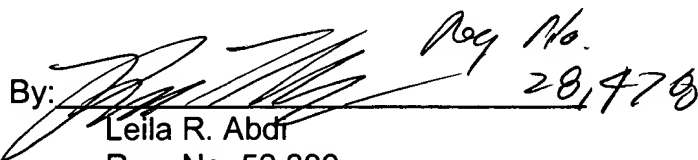
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: February 21, 2006

By:  *Reg No. 28,478*  
Leila R. Abd  
Reg. No. 52,399

**Attachments:**      **Replacement FIG 2C**  
                             **New FIGs. 2A-B, 6A-C, and 20-24**  
                             **Exhibit A (1988 materials)**  
                             **Exhibit B (copy of specification as amended)**